

REMARKS

The Abstract of the application is objected to because it exceeds one paragraph. Similarly, the specification is objected to for informalities and for not including a complete priority statement.

Pending claims 1-12 have been rejected for obviousness-type double patenting as being unpatentable over claims 1-17 of U.S. Patent No. 6,150,173. Claims 1-12 have also been provisionally rejected for obviousness-type double patenting as being unpatentable over claims 1-15 of copending Application No. 09/808,224.

Claims 1-12 are further rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention.

Claims 1, 4-6, 9, 10 and 12 are amended herein and new claim 13 has been added. Support for the amended and added claims can be found throughout the specification and claims as originally filed. The amendments made herein are further explained below. No new matter has been added.

Any amendments to the claims should in no way be construed as acquiescence to any of the Examiner's rejections and was done solely to expedite the prosecution of the application. Applicant reserves the right to pursue the claims as originally filed in this or a separate application(s).

Applicant respectfully requests reconsideration and withdrawal of the Examiner's objections and rejections in view of the above amendments and the remarks herein.

General Objections

The Examiner objected to the Abstract of the application because it exceeded one paragraph. Applicant has amended the Abstract to comply with the Examiner's objection and submits that the objection has been overcome.

The Examiner also objected to page 1 of the specification because it includes a sticker with an express mail number. Applicant acknowledges that the sticker is included on page 1, although such is common practice in the filing of a U.S. patent application. With deference to this practice, Applicant respectfully requests that the Examiner reconsider and withdraw the objection.

The Examiner further indicated that the application did not include a complete priority statement. Applicant appreciates the Examiner's comment and Applicant has inserted a complete statement of priority in the application.

Claim Rejections - Obviousness-Type Double Patenting

Claims 1-12 are rejected for obviousness-type double patenting over claims 1-17 of U.S. Patent No. 6,150,173. Claims 1-12 have also been provisionally rejected for obviousness-type double patenting over claims 1-15 of copending Application No. 09/808,224.

Applicant respectfully traverses the foregoing rejections. Applicant contends that claims 1-12 are not obvious over U.S. Patent No. 6,150,173 or Application No. 09/808,224. In turning first to U.S. Patent No. 6,150,173, the Examiner has not demonstrated that *all* of the elements for a *prima facie* case of obviousness are disclosed in the reference. Specifically, the

reference does not mention any step in which a heterogeneous cell mixture is applied to an object with cells and with corresponding target structures binding to that object as recited in claims 1 and 12 of the application. In contrast, the reference merely recites such reagents as colorants, complexing agents, lectins, biotoxins, antibodies, ligands or the like which mark specific groups or places in the object to be examined.

Additionally, Applicant discloses identifying protein combination patterns on the surface of cells which are responsible for binding to the defined structures as well as enriching the cells with these identified protein patterns. This identification process is not taught or suggested in U.S. Patent No. 6,150,173 such that an obviousness-type double patenting rejection would be proper. The reference is also not directed to enriching cell-specific target structures, unlike the method recited by Applicant.

Now, turning to Application No. 09/808,224, it is understood that this reference is directed to identifying cell-specific target structures. Claims 1 and 12, however, recite method steps for both identifying and *enriching* cells with identical cell-specific target structures. The reference does not teach or suggest this method step. Thus, Applicant submits that the Examiner has not demonstrated that *all* of the elements for a *prima facie* of obviousness are suggested in Applicant No. 09/808,225 such that a provisional rejection for obvious-type double patenting would be proper.

In view of the foregoing arguments, Applicant respectfully requests reconsideration and withdrawal of the obvious-type double patenting rejections of claims 1-12.

Claim Rejections - 35 U.S.C. § 112, 2nd Paragraph

Claims 1-12 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite.

Applicant respectfully traverses the foregoing rejection. Nonetheless, claim 1 has been amended to recite "a" surface, thereby overcoming a lack of antecedent basis. Claim 5 is also amended to clarify the recitations of "in a particular protein separation process" and "by means of a molecule or a molecular complex separation process." Applicant notes that definitions for and examples of the terms "molecule" and "molecular complex" in the latter recitation are provided in the specification, such as on page 5, lines 7-9, which discloses a protein separation process.

Although claims 4, 9, 10 and 12 are rejected for not clearly identifying the metes and bounds of Y_n ($n = 2, 3, \dots, N$) and X_n ($n = 2, 3, \dots, N$), Applicant respectfully disagrees with the Examiner's argument. It is generally understood that $n = 2, 3, \dots, N$ recites a sequential group of numbers which, in claim 1, are identifiers. Specifically, Y_n and X_n identify different reagent solutions and objects, respectfully. A person of ordinary skill in the art would consider this claim language as definite as the nomenclature allows one to distinguish between different solutions and objects.

Based on the foregoing amendments and arguments, Applicant respectfully requests reconsideration and withdrawal of the rejection of claims 1-12 for indefiniteness.

Applicant submits that all claims in the application are in condition for allowance and such action is requested.

Application No. 09/808,225
Filed: March 14, 2001
TC Art Unit: 1645
Confirmation No.: 2805

The Examiner is encouraged to telephone the undersigned attorney to discuss any matter that would expedite allowance of the present application.

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